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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/022,639

12/17/2001

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P05150US0

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27139 7590 01/26/2007  
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EXAMINER

WRIGHT, JAMES B

ART UNIT

PAPER NUMBER

3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/022,639

Applicant(s)

AMENSEN ET AL.

Examiner

J. Bradley Wright

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-15, 17-22 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-15, 17-22 and 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Acknowledgements***

1. The examiner for this application has changed. Please indicate Examiner J. Bradley Wright as the examiner of record in all future correspondences.

***Continued Examination Under 37 CFR 1.114***

2. Receipt is acknowledged of a Request for Continued Examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and an amendment/reply, filed on October 23, 2006.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 17-19, 21-22 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, as follows:

- claim 17, lines 6-8, the limitation wherein "each of the customers being authorized for delivery and installation of the at least one product purchase selection to the zip code," is not supported by the specification;

Art Unit: 3693

- claim 21, lines 8-9, the limitation wherein "receiving information from a consumer necessary to complete a transaction on the manufacturer web site and transferring the information to the retailer web site," is not supported by the specification; and
- claim 27, lines 9-11, the limitation wherein "the web site shares the online consumer with the customer web site in a guarded manner to assist in not losing a sale of the product purchase selections," (emphasis added) is not supported by the specification.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 9-11, 13-15, 21-22, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danneels, et al. (US Patent No. 6,272,472) (previously cited) in view of Dworkin (US Patent No. 4,992,940) (previously cited).

Art Unit: 3693

5. Regarding claims 1, 6, 10, 13-14 and 27, Danneels teaches an electronic commerce system for transfer of at least one product purchase selection (see Abstract and Figures 1 and 2) comprising:

- a first web site adapted to communicate product information to consumers and adapted to receive at least one product purchase selection from a consumer (item 112 in Figure 1, item 212 in Figure 2, and column 3, lines 19-32); and
- a cart transfer for transferring the at least one product purchase selection from the first web site to a shopping cart of a second web site (column 3, line 45 – column 4, line 6).

The Examiner notes that Danneels teaches a dynamic linking of supplier web sites (first website) to reseller web sites (second website) which includes the supplier (first) web site adapted to communicate product information to consumers and adapted to receive at least one product purchase selection from the consumer (see for example column 3, lines 25-32). Danneels further teaches a reseller entering information including information regarding the items of the supplier that are sold available from the reseller (see for example column 3, lines 2-18). Examiner further notes that transfer of the shopping list to the reseller website so that the user does not have to reselect the list of items to be purchased one her or she is linked to the reseller's web site," and "the purchaser being shown a list of items that were previously selected, along with prices therefor, such that the purchaser has the opportunity to change quantities of the items purchased," represents a transfer of product purchase selections to a "shopping cart".

Art Unit: 3693

However, Danneels does not explicitly disclose the first web site being further adapted to display a price of the product purchase selection prior to transferring the product purchase selection to the shopping cart of the second web site to thereby assist consumers in making purchasing decisions prior to leaving the first web site. Danneels does, however, disclose that the selection of items to purchase at the supplier site (and prior to transfer to the reseller site) may "entail the browsing of an on-line catalog, such that the purchaser adds desired items to an on-line shopping cart, as known in the art." (column 3, lines 28-31). The Examiner takes Official Notice that it was old and well known in the art that catalogs (on-line or otherwise) provide necessary product information to the user in order to assist the user in the decision-making process.

Dworkin teaches an automated system to assist users in locating and purchasing goods or services sold by a plurality of vendors that facilitates the purchasing decision of the user by providing users with a plurality of product information, including a listing of price, specifications (policies) and availability prior to selection and purchase by the user (see Figures 6-7, and column 2, lines 19-41), for the purpose of greatly reducing the amount of time required in shopping for products (see column 2, lines 63-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that the product information entered by the reseller and presented to purchasers in the on-line catalog of Danneels to include information to assist the user in the decision-making process, such as price, specifications (policies) and availability, as taught by Dworkin. One of ordinary skill in the art would have been motivated to

Art Unit: 3693

modify the references in order to greatly reduce the amount of time required in shopping for products.

6. Regarding claim 2, Danneels further teaches one or more inputs for receiving information about consumer preferences (see for example column 3, lines 40-44).

7. Regarding claim 3, Danneels further teaches wherein the first website is a manufacturer website (supplier) and the second website is a customer website (reseller) (see for example Background of the Invention).

8. Regarding claim 4, Danneels further teaches a shopping cart on the first website associated with the consumer and adapted to maintain the product purchase selection (see for example column 3, lines 29-31).

9. Regarding claim 5, Danneels further teaches a customer selection component adapted for the consumer to select the second website (see for example column 3, lines 45-47).

10. Regarding claim 7, Danneels further teaches the capability of the product purchase selection being an appliance. Examiner notes that claim 7 is an apparatus claim, as such the claim distinguish itself over the reference based on its structure. The

Art Unit: 3693

type of product selected relates to the function of the apparatus and as such the system of Danneels need only be capable of use with appliances to anticipate the claim.

11. Regarding claim 9, Danneels further teaches wherein the cart transfer includes passing a product identifier (see for example column 6, lines 45-47).

12. Regarding claim 11, Danneels further teaches dynamically generating and displaying a list of resellers from which the purchaser can directly purchase items prior to transferring the selected product from the supplier (first) website to the reseller (second) website (see column 3, lines 34-45).

13. Regarding claim 15, as described above, the combination of Danneels and Dworkin discloses an electronic system for transfer of at least one product purchase selection, including a manufacturer web site adapted to communicate product information and product pricing to consumers and adapted to receive information sufficient for consumers to make product purchasing decisions without leaving the manufacturer web site, adapted to communicate product pricing to consumers and adapted to receive product purchase selection information from a consumer, and a cart transfer for automatically transferring at least one product purchase selection from the manufacturer web site to a shopping cart of a customer web site selected by the consumer. Danneels further teaches the transfer of a product identifier (see for example column 3, lines 50-55). However, Danneels does not explicitly disclose that



Art Unit: 3693

the product purchase selection information includes user information. The Examiner notes that Applicant's Specification provides little guidance regarding the definition of "user information". In light of the Specification, the term is construed to mean any information regarding the user necessary for completing the transaction, for the purposes of examination.

Dworkin teaches that a user can order a product through the system by selecting a product by its identifier. The system then prompts the user for information necessary to complete the transaction and forwards this information on to the selected supplier (column 2, lines 34-40). Dworkin teaches this is done in order to eliminate the need for users to consult hundreds or thousands of suppliers directly (see column 1, lines 57-61).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the teachings of Danneels to include prompting a user for information necessary to complete a transaction (i.e. user information) and then forwarding this information on to the supplier as taught by Dworkin. One of ordinary skill in the art would have been motivated to make such a modification in order to eliminate the need for users to consult hundreds or thousands of suppliers directly as taught by Dworkin.

14. Regarding claim 21, as described above, the combination of Danneels and Dworkin discloses a method of selling merchandise to consumers using a manufacturer web site, including maintaining current information regarding products on the manufacturer web site, receiving a product purchase selection on the manufacturer web site, providing pricing information for the product purchase selection on the

Art Unit: 3693

manufacturer web site, providing information regarding a plurality of retailers on the manufacturer web site, receiving a selection of one of the plurality of retailers, and automatically transferring the product purchase selection to a shopping cart on the web site associated with the selection of the one of the plurality of retailers.

However, Danneels does not explicitly disclose receiving information from a consumer necessary to complete a transaction on the manufacturer web site and transferring the information to the retailer web site.

As noted above, Dworkin teaches that a user can order a product through the system by selecting a product by its identifier. The system then prompts the user for information necessary to complete the transaction and forwards this information on to the selected supplier (see for example column 2, lines 25-40). Dworkin teaches this is done in order to eliminate the need for users to consult hundreds or thousands of suppliers directly (column 1, lines 57-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Danneels to include prompting a user for information necessary to complete a transaction and then forwarding this information on to the supplier as taught by Dworkin. One of ordinary skill in the art would have been motivated to make such a modification in order to eliminate the need for users to consult hundreds or thousands of suppliers directly as taught by Dworkin.

15. Regarding claim 22, Danneels further discloses confirming that the shopping cart transfer is complete at the manufacturer's website (column 4, lines 7-8).

Art Unit: 3693

16. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Danneels in view of Dworkin, as applied to claim 1 above, and in further view of Microsoft Computer Dictionary.

Danneels does not teach the cart transfer includes a XML transfer. However Danneels does teach an HTML code for transfer of product information (cart transfer). As such Examiner relies on Microsoft Computer Dictionary to teach that XML is a condensed form of SGML which lets developer and designers create customized tags that offer greater flexibility in organizing and presenting information than is possible with older coding systems such as HTML (page 48%). In other words, Microsoft Computer Dictionary teaches that (XML is an old and well known web/Internet coding standard (also see definition of SGML on page 405).

As such, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the HTML coding of Danneels to XML and in particular to have the cart transfer include an XML transfer, as taught to be old and well known by Microsoft Computer Dictionary. One of ordinary skill at the time of the invention would have been motivated to modify the reference to offer greater flexibility in organizing and presenting information than would have been possible with older coding systems.

17. Claim 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danneels in view of Gerszberg, et al. (US Patent No. 5,970,473) (previously cited).

Art Unit: 3693

Danneels, as discussed in detail above, further teaches narrowing the list of resellers from which a user can purchase items based on those resellers in the purchaser's proximate geographic area (see column 3, lines 37-45). However, Danneels does not specifically recite, "receiving a zip code from the online consumer" nor "each of the customers being authorized for delivery and installation of the at least one product purchase selection to the zip code." Examiner notes that this represents identifying a delivery area for each customer and identifying consumers in that area.

Gerszberg teaches users enter an address, which he/she can designate as a delivery address for products and services (see for example column 8, lines 57-60). Examiner notes that this represents entering a zip code. Gerszberg further teaches an online database query to determine a list of pizza companies (customers) that deliver to a delivery address (consumer's zip codes) (see for example column 9, lines 19-30). Gerszberg teaches that this system provides consumers a simple process for ordering goods and services (see column 10, lines 14-16).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the teachings of Danneels to allow users (consumers) to enter a delivery address (zip code) as taught by Gerszberg and to further modify the list of resellers of Danneels (see Danneels column 3, lines 37-45) based on those resellers who will delivery and install the product to the user's address (zip code) as taught by Gerszberg. One of ordinary skill in the art would have been motivated to make these modifications in order to provide consumers a simple process for ordering goods and services as taught by Gerszberg.

Art Unit: 3693

18. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Danneels in view of Gerszberg applied to claim 19 above, and in further view of Applicant's Disclosure.

Danneels, as described in detail above, does not specifically teach that the supplier sells appliances. Applicant admits in the "Problems in the Art" section that it is old and well known for appliance manufacturers to sell their appliances over the Internet. Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention modify the products sold in Danneels to specifically include appliances, as it admitted to be old and well known by Applicant. One of ordinary skill in the art would have been motivated to modify the references in order to facilitate the purchase of appliances between the buyers and the manufactures.

19. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Danneels in view of Dworkin, as applied to claim 1 above, and in further view of Hazi, et al. (US Patent Application Publication No. 2005/0125310)

As described in detail above, the combination of Danneels and Dworkin discloses a method for directing consumers to online partners to complete product purchase transactions, the method including providing a web site accessible to a consumer, receiving a product purchase selection of one of the plurality of products from the consumer using the web site, presenting online partner information on the web site associated with online partner, the online partner information comprising pricing and availability of the product purchase selection to assist the consumer with determining

Art Unit: 3693

whether to purchase from the online partner without leaving the web site, receiving an online partner selection from the consumer using the web site, transferring the product purchase selection to a shopping cart of a second website, the second web site associated with the online partner selection to limit the interaction needed between the consumer and the second web site to complete a sales transaction and assist in capturing sale of the product selected for purchase.

However, Danneels does not explicitly disclose maintaining current product information on the web site for a plurality of products.

Hazi discloses a system for creating online catalogs that are pre-populated with product information that include an interface for the efficient update and maintenance of product information (paragraphs [0008] – [0009]) for the purpose of permitting rapid update and integration of new product information to provide the latest information to users of the catalog (paragraph [0007]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Danneels to incorporate an interface for the efficient update and maintenance of product information, as taught by Hazi, in order to permit rapid updating and integration of new product information into the online catalog viewed by users.

20. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Danneels in view of Dworkin as applied to claim 1 above and in further view of Admitted Prior Art.

Danneels teaches narrowing the list of resellers from which a user can purchase items based on those resellers in the purchaser's proximate geographic area (see column 3, lines 37-45). However, Danneels does not specifically recite that to find resellers based on proximate geographic area a zip code is used. The Examiner took Official Notice in the Office Action of January 9, 2006 that it is old and well known in the art to determine a purchaser's proximate geographic area with a zip and that one of ordinary skill in the art would recognize that a zip code a standard geographical locator and would be used in order to capitalize on this pre-established standard.

As Applicant failed to traverse this assertion in the subsequent response on April 10, 2006, it was found to be Admitted Prior Art in the Office Action of June 21, 2006. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the narrowing of the list of resellers of Danneels by using a zip code submitted by the customer as is old and well known. One of ordinary skill in the art would have been motivated to modify the reference in order to capitalize on the pre-established zip code standard.

### ***Response to Arguments***

21. Applicant's arguments filed 10/23/06 have been fully considered but they are not persuasive.

22. Applicant's arguments begin on page 9 of the amendment filed 10/23/06. On page 9, Applicant asserts that, "neither reference (Dworkin & Danneels) addresses

Art Unit: 3693

precisely the same problem as addressed by the present invention - wanting to increase the likelihood that a sale referred to an online partner is consummated." Applicant supports this by stating, "the present invention provides significant and substantial benefits over Danneels. Applicant further supports this position by citing *In Re Wright*, 6 USPQ2d 1959 (Fed. Cir. 1988) and *In Re Bishay* (sic), 94 USPQ 80 (CCPA 1952).

While the problem to be solved (and the discovery thereof) may indeed be relevant, the Examiner notes that *In Re Bisley* also states that "Applicant's right to patent claims depends not only on what new and unobvious results his disclosed device will produce but also on whether claims adequately recite feature which produces these results and upon which applicant predicates patentability" (emphasis added). It is the Examiner's position that there are inadequate limitations recited in the claims, as currently presented, to produce the benefits claimed by the Applicant. In particular, there are no limitations in the claims that enable the system to "control" the purchasing process, as alleged by Applicant.

As described in detail above, the combination of Danneels and Dworkin clearly render the claims, as presented, obvious. Thus, in response to Applicant's argument that neither reference addresses the same problem or solves the problem identified and resolved by the claimed invention, the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).



Further, according to MPEP § 2144, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. (see, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention).

23. The Examiner further disagrees that Applicant's primary problem addressed by the present invention is the desire to increase the likelihood that a sale referred to an online partner is consummated. Turning to Applicant's Specification, specifically the section titled "Problems in the Art" found on page 1, line 12 through page 5, line 22, Examiner fails to find this problem mentioned.

However, Examiner does find numerous problems mentioned that are addressed by Danneels, in view of Dworkin. For example page 3, lines 7-10, "A further problem with simple link-puts is that consumers starting on a manufacturer's web site must go through an entire navigations process to find the product they want." Also page 3, lines 15-19, "A further problem is that if a consumer desires to check price and availability with more than one retailer, they must repeat the entire navigation process in each of the retailer's web sites."

Art Unit: 3693

24. Applicant contends that the terminology of "cart transfer" connotes that the buying decision has been made and a consumer is ready to check out. Notwithstanding whether or not a buying decision has been made by a cart transfer, there are no limitations in the claims, as presented, that control or secure the sale on the reseller's website. For example, upon a cart transfer to the reseller website, the user may lose his Internet connection, power off his computer, or simply redirect his browser to an alternate website for any of a number of reasons. Thus, even assuming, *arguendo*, that a cart transfer did connote a user's readiness to check out, Applicant's present invention cannot control a buyer's decision framework regarding the purchase of an item. Therefore, It is the Examiner's position that the systems and methods, as presented in the claims, cannot control whether or not a consumer makes a decision to buy.

For further sake of argument, if the process of a "cart transfer" is in fact a manifestation of a consumer's decision to buy a product, as alleged by the Applicant, then one must apply that same fact to a consumer using the system of Danneels. In other words, Applicant would have to be arguing that, under this scenario, the manifestation of a consumer's decision to buy is the inherent result of transferring his product purchase selections to the second website. Thus, when a consumer's selections are transferred from the supplier's website to the reseller's website in the system of Danneels, it must, under Applicant's argument, be a manifestation of his decision to purchase the selected products. Therefore, by Applicant's own arguments, Danneels secures or controls the sale of a selected product to at least the same extent as Applicant's claimed systems and methods.

Art Unit: 3693

25. Applicant contends that the claimed invention provides for presenting information on the manufacturer website sufficient for a consumer to make a buying decision before the consumer leaves the manufacturer website. Applicant further argues that by controlling the presentation of information and making it available on the manufacturing website, the buying decision may be made at the manufacturer website, and the sale consummated at the reseller website. As discussed in detail above, Danneels teaches this very system by allowing a user to browse and select products from an on-line catalog prior to transferring selections to a reseller site.

Applicant attempts to differentiate Danneels by arguing that Danneels “does not disclose providing pricing information for the reseller on the supplier’s website.” (emphasis added). The Examiner is unsure as to what the Applicant is arguing. In particular, whether the Applicant is referring to pricing information specific to the reseller or simply providing pricing information to the reseller. If the former, then the Examiner notes that none of the independent claims, with the possible exception of claim 25, contain such a limitation. Notwithstanding, the Examiner has addressed this issue in detail above within the rejection of the claims as being obvious in view of the combination of Danneels and Dworkin, wherein the Examiner submits that it would have been obvious to modify the information in the on-line catalog browsed by the users of Danneels to include pricing information, as taught by Dworkin. Indeed, as noted by Applicant, pricing would be a key buying criteria for a user in determining whether to buy an item, and where to buy it.

Art Unit: 3693

26. Regarding claim 1, Applicant argues that neither Danneels nor Dworkin disclose the limitation of displaying a price of the product prior to transferring product selections to the second website. Examiner believes that the position of the Examiner is clear, as this issue has been addressed above.

Applicant further argues against Dworkin individually noting that in Dworkin, the user only interacts with a single system. The Examiner notes that *In Re Bisley*, cited by the Applicant, also states that "[c]laims may be rejected on combination of several patents taking specific features from each" and that "it is not necessary that complete disclosure be contained in single reference."

In any event, in response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner notes that Dworkin is cited merely to show the types of product information provided to users by an analogous system in order to assist in a purchasing decision.

Applicant also argues that the combination of Danneels and Dworkin is merely based on improper hindsight stemming from a faulty motivation or suggestion to combine. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

Art Unit: 3693

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner notes that the motivation to combine the references was found in the cited references themselves, as indicated above, and not from the Applicant's disclosure.

Further, Applicant argues that motivation to combine the references is faulty because it comes from the perspective of the consumer. However, as noted above, according to MPEP § 2144, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. (see *In re Kahn*, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

Art Unit: 3693

27. Regarding claim 10, Applicant argues that neither Danneels nor Dworkin disclose the limitation of displaying a price of the product prior to transferring product selections to the second website. Examiner respectfully disagrees. As pointed out above, this is precisely what the combination of Danneels and Dworkin teaches. In fact this is specifically the feature Dworkin is used to teach.

28. Regarding claim 15, Applicant again argues that neither Danneels nor Dworkin disclose the limitation of displaying a price of the product prior to transferring product selections to the second website. Examiner believes that the position of the Examiner is clear, as this issue has been addressed above.

Applicant further argues that neither reference teaches that the product information comprises a product identifier and user information. The Examiner respectfully disagrees with the Applicant's position. As described in detail above at item 13, the combination of Danneels and Dworkin disclose the limitations and render the claimed invention obvious.

29. Regarding claim 21, once again Applicant argues that neither Danneels nor Dworkin disclose the limitation of displaying a price of the product prior to transferring product selections to the second website. Examiner believes that the position of the Examiner is clear, as this issue has been addressed above.

Applicant further argues that neither reference discloses receiving information from a consumer necessary to complete a transaction on the manufacturer website and transferring the information to a retailer website. The Examiner respectfully disagrees and notes that the system of Dworkin prompts the user for information necessary to complete the transaction and forwards this information on to the selected supplier, as described in detail above at item 14.

30. Regarding claim 25, Applicant's arguments with respect to claim 25 have been considered but are moot in view of the new ground(s) of rejection.

31. Regarding claim 26, Applicant argues that the combination of Danneels and Dworkin disclose the invention of claim 1. Examiner believes that the position of the Examiner is clear, as this issue has been addressed above.

32. Regarding claims 17-19, Applicant argues that the motivation or suggestion to combine the references used by the Examiner is improper, and thus merely relying on impermissible hindsight.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, as previously noted, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed

Art Unit: 3693

invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the Examiner again recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner notes that the motivation to combine the references was found in the cited references themselves, as indicated above, and not from the Applicant's disclosure.

Again, Applicant argues that motivation to combine the references is faulty because it comes from the perspective of the consumer. However, as noted above, according to MPEP § 2144, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See *In re Kahn*, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).



Art Unit: 3693

33. Regarding claim 8, Applicant again argues that the combination of Danneels and Dworkin disclose the invention of claim 1. Examiner believes that the position of the Examiner is clear, as this issue has been addressed above.

34. Regarding claim 20, Applicant argues that claim 20 depends upon claim 19, and claim 19 is not unpatentable over the combination of Danneels, Gerszberg, in view of Applicant's Disclosure. The Examiner respectfully disagrees and points to the rejection of claim 19 at item 17, and the response to arguments regarding claim 19 discussed in detail at items 32.

### ***Conclusion***


35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bradley Wright whose telephone number is (571) 272-5872. The examiner can normally be reached on M - F 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

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jbw

 1/23/07  
James Kramer